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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Feeney et al.
For : **GAME BALL WITH IMPROVED MOISTURE
RESISTANCE**
Serial No. : 09/248,595
Filed : February 11, 1999
Group Art Unit : 3711
Examiner : Aryanpour, Mitra
Last Office Action : April 2, 2004
Confirmation No. : 8963
Attorney Docket No. : P-5761-SPALD
(RUSS 200007)

**COMMUNICATION AND TRANSMITTAL OF
RULE 37 C.F.R. § 1.192 APPELLANTS' BRIEF**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Dear Sir:

Enclosed is a RULE 37 C.F.R. § 1.192 APPELLANT'S BRIEF for filing
in the above-captioned case. The fee of \$340.00 is enclosed.

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on Nov. 8, 2004.

By: Mary Ann Temesvari
Mary Ann Temesvari

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A check in the amount of \$340.00 is enclosed.

Applicants hereby petition the Commissioner under 37 C.F.R.1.136(a) and request any additional extensions of time that may be necessary and authorize the extension of time fees to be charged to Deposit Account No. 06-0308.

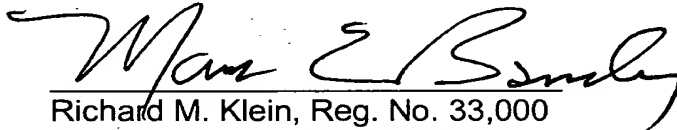
The Commissioner is authorized to charge any additional fees, or refund any overpayment to Deposit Account No. 06-0308.

Respectfully Submitted,

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Date

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re the Application of: Feeney et al.

Application No.: 09/248,595

Examiner: Aryanpour

Filed: February 11, 1999

Docket No.: P-5761-SPALD
(RUSS 200007)

For: GAME BALL WITH IMPROVED MOISTURE RESISTANCE

BRIEF ON APPEAL

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Appeal from Group 3711

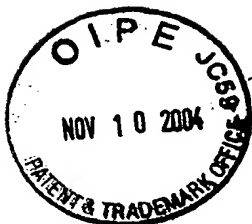
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Application No. P-5761-SPALD
RUSS 200007

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Application No. P-5761-SPALD
RUSS 200007

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Spalding Sports Worldwide, Inc. (now Russell Corporation), by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 010067, Frame 0927.

II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

Following are identified any prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal:

It is noted that the present application was previously on appeal to the Board as Appeal No. 2002-0979. That appeal involved a rejection of claims 1-6, 8-12, 17 and 18 under 35 U.S.C. §103. The Board refused to sustain the Examiner's rejection.

The Board also entered a new ground of rejection under 35 U. S. C. §102 based upon U.S. Patent 5,069,935 to Walters. That rejection concerned claim 11, which is not at issue in the present appeal. Additionally, the Board remanded the application back to the Examiner for further consideration as to whether certain claims met the written description requirement under 35 U.S.C. § 112, first paragraph.

III. STATUS OF CLAIMS

Claim 3 is on appeal.

Claim 3 is pending.

Claim 3 is rejected.

Claims 1-2 and 4-20 are canceled.

IV. STATUS OF AMENDMENTS

Subsequent to the final Action mailed on April 2, 2004, Applicant submitted a paper requesting reconsideration of the rejections. That paper was filed on June 2, 2004. No amendments were presented. The Examiner mailed an advisory Action on July 28, 2004 maintaining all previous rejections.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter of claim 3 is directed to a game ball having increased resistance to moisture absorption comprising a natural leather cover disposed over a lining (see page 4, lines 2-3; and lines 12-15 of the present application). The leather of the cover has increased water resistance properties distributed throughout during a tanning process, wherein when the ball is subjected to six 45 minute cycles of a rain test (see page 5, lines 5-21; and page 11, lines 9-13) and the ball is permitted to dry at approximately 70° F for 24 hours between cycles (see page 13, lines 20-22). The ball contains an amount of water at the conclusion of each of the rain test cycles as expressed as a ratio of the weight of the ball with the absorbed water to the weight of the dry ball, with an average per cycle ratio at the conclusion of the six rain test cycles being a maximum of 1.20:1 (see Table 1B).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

The Examiner objected to the drawings.

Claim 3 was rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement.

Claim 3 was also rejected under § 112, first paragraph, for alleged lack of enablement.

VII. ARGUMENT

A. Objection to the Drawings Must Be Reversed

In support of this, the Examiner contended:

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, *a game ball having a cover, a lining and no bladder* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

Page 2 of the Office Action mailed April 2, 2004 (emphasis in original).

In a previous Office Action mailed June 26, 2003, the Examiner objected to the drawings and requested that they illustrate a "game ball having a cover and a bladder." Applicants then remedied that ground of objection.

Now, the Examiner objected to the drawings and requested that they illustrate a "game ball having a cover, a lining, and no bladder." Even in the event that the Examiner's objection was supportable, this most recent objection should have been raised in the previous Office Action. It is entirely unfair and inequitable for the Examiner to raise this new ground of objection in a final Office Action.

The Examiner contested this in the noted Advisory action and argued:

With regards to the remarks on the Objection to the Drawings, Applicant's assertion that "it is entirely unfair and inequitable for the Examiner to raise this new ground of objection in a final Office Action. Such assertions are not understood, since the objection to the drawings was raised in Paper No. 28 dated 12 June 2003.

Page 2 of the July 28, 2004 Advisory Action (emphasis in original).

No. The Examiner is wrong. In the Office Action mailed June 26, 2003 (to which the Examiner refers as "dated 12 June 2003"), the Examiner objected to the drawings on grounds that they show a game ball having a cover and a bladder. Applicants previously remedied that ground of rejection. The Examiner did not object to the drawings in that earlier Action on grounds that they did not show a game ball having a cover, a lining, and no bladder.

Notwithstanding the untimeliness in raising the present objection and the Examiner's apparent confusion, it is also without merit for the following reason. Claim 3, the only pending claim, recites a game ball with certain properties, the ball comprising a natural leather cover disposed over a lining. Claim 3 does not recite that the ball does not comprise a bladder. In fact, claim 3 includes game balls that utilize bladders so long as the ball exhibits the characteristics recited in that claim.

Furthermore, the Examiner raised the objection under 37 CFR § 1.83. A careful reading of that section reveals that it states that drawings "must show every [nonconventional] feature of the invention specified in the claims" (bracketed text added). Thus, the Examiner's objection implies that claim 3 is reciting game balls with "no bladder." No, that is not what claim 3 recites.

In the Advisory Action, the Examiner also argued that:

With regards to Applicant's assertion that the objection is without merit. Again applicant's assertion is not understood, 37 CFR 1.83(a) requires that the drawings must show every feature of the invention specified in the claims. The claimed game ball is a game ball having a cover and a lining. This particular combination results in the claimed results. Therefore, this combination must be shown.

Page 2 of the July 28, 2004 Advisory Action (emphasis in original).

Now it appears that the Examiner is changing the grounds of the objection again! In the final Action, the Examiner insisted that a game ball having a cover, a lining, and no bladder be shown. Then in the Advisory Action, the Examiner is insisting that a game ball having a cover and a lining be shown. Which is it?

It is believed that upon further review, the Board will agree that the present objection must be reversed. The present drawings sufficiently show every feature of the claimed game ball.

B. Rejection of Claim 3 for Alleged Lack of Written Description Support
Must Be Reversed

As noted, the present application was previously before the Board as Appeal No. 2002-0979). Although the Board did not sustain the Examiner's rejection under 35 U.S.C. § 103, the Board remanded the case for determination of whether certain claims, including claim 3, met the written description requirement of 35 U.S.C. § 112, first paragraph.

In response to the Board's remand, Applicants submitted a Response to Decision on Appeal, filed March 11, 2003, in which claim 3 was amended. That amendment introduced the maximum average per cycle ratio of 1.20:1 presently recited in claim 3. As explained in that Response, that claim 3 as amended, satisfied the written description requirement under § 112 because it modified claim 3 to be consistent and clearly supported by the specification and claims as originally filed. Accordingly, the concern by the Board was remedied and is now moot.

Subsequent to Applicants' Response to Decision on Appeal, the Examiner rejected claim 3 by asserting:

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, had possession of the claimed invention, *Applicant has failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved during the alleged tanning process for the full range of weight ratios which is critical or essential to the practice of the invention.*

Applicant has mentioned in the specification (page 10) several suitable leathers, which are commercially available, but has failed to disclose what process has been used to produce the "increase water resistant properties" in the natural, leather or that at the time of filing of this application applicant was in possession of this information? Therefore, it is unclear how the unexpected results have been reached, since one skilled in the art will not be able to make or use applicant's invention as originally filed.

Pages 2-3 of the Office Action mailed April 2, 2004 (emphasis in original).

Applicants revisited this matter and the Examiner's latest allegations. Now, the Examiner asserts that Applicants "failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved."

First, the Board is respectfully requested to re-read Applicants' previous Response filed December 29, 2003,¹ and specifically pages 5-9 of that Response. There, the correct standard for evaluating written description under § 112 is set forth as pronounced by the Court of Appeals for the Federal Circuit. And, there, supporting written description in the present application is noted.

Now, in the Examiner's final Office Action, the Examiner is demanding a scientific explanation as to "how" the increased water resistant properties are achieved.

Frankly, the exact scientific mechanism is not, at this time, known. Although Applicants have certain theories in mind, or may speculate, the exact physical process has not been specifically determined.

However, and more importantly for the present rejection, is that the patent laws do not require exact specific explanation of scientific phenomena which may be occurring in the practice of claimed subject matter. In fact, the Court of Appeals for the Federal Circuit has even held that a patentee's misconceptions about the scientific principles underlying a patent are not cause for invalidating that patent:

[A]n otherwise valid patent covering a meritorious invention should not be struck down simply because of the patentee's misconceptions about scientific principles concerning the invention, see *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1570, 219 U.S.P.Q. 1137, 1140 (Fed. Cir. 1983).

Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1359, 52 USPQ.2d 1029 (1999). In fact, the Federal Circuit has long held that "[i]t is axiomatic that an inventor need not comprehend the scientific principles on which the practical

¹ This Response addressed the Office Action mailed June 26, 2003.

effectiveness of his invention rests.” *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 219 USPQ 1137, 1140 (Fed. Cir. 1983).

In the noted Advisory Action, the Examiner attempted to skirt the previous demand for an exact description of how the increased water resistant properties are achieved. Here, the Examiner argued:

Applicant’s assertion with regards to “the Examiner is demanding a scientific explanation as to how the increased water resistant properties are achieved” is not understood, since no “scientific explanation” has been requested. As Applicant has demonstrated, not all game balls possess the claimed water resistant properties as the inventive game ball. Therefore, for a clear understanding of the invention, it is necessary to know the particulars of the structure and process that makes up the inventive game ball. As indicated in the previous Office Action, the specification as originally filed does not provide the requisite written description for the claimed property. Applicant has merely referred to several suitable leathers, which are commercially available, but has failed to disclose what process has been used to produce the “increase water resistant properties” in the natural leather? Again, Applicant has failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved during the alleged tanning process for the full range of weight ratios which is critical or essential to the practice of the invention. Therefore, it is unclear how the unexpected results have been reached, since it appears that the tanning imparted on the leather yields to these unexpected results.

Page 2 of the July 28, 2004 Advisory Action.

Again, it is unclear why the Examiner continues to demand an exact explanation as to “how the increased water resistant properties... has been achieved.” The Examiner also alleges that no process has been disclosed as to how to produce the increased water resistant properties. As repeatedly described in the specification, the increased water resistance properties are imparted to the leather during the tanning process of the leather. The nature of the increased water resistance properties is recited by claim 3 in terms of a maximum amount of water that is absorbed during a particular rain test. Claim 3 expressly recites the parameters of this rain test.

It is respectfully urged that the present application, as originally filed, does in fact provide the requisite written description for this claimed property:

The leather used in the cover of the ball is prepared by a

tanning process and using tanning materials which impart the desired water resistance properties to the leather. The inventors have found that the water resistance properties imparted in the tanning process are longer lasting and provide better water resistance than surface treatments conventionally used on game balls. The water resistance properties imparted by the tanning process are distributed throughout the leather and are associated with each fiber of the leather and not simply on the outer surface of the leather. Because of the distribution of the water resistance properties throughout the leather, water which contacts the leather is typically unable to find an untreated area at which to be absorbed, including the stitching lines between panels, the panel edges and the back or split side of the leather cover. Furthermore, because the water resistance properties are distributed throughout the leather, the properties are not readily susceptible to wearing or washing away, as are the water resistance treatments applied to the surface of other conventional game balls.

Page 5, lines 5-21.

The cover material 16 is formed of a leather which has been tanned by a process using chemicals for imparting water resistance properties to the finished leather. The leather used in the cover of the ball may be one of the type which is traditionally used for such a ball. For example, in an American-style football as shown in Figure 2, the leather would traditionally be a cowhide leather. Similarly, a baseball would also traditionally have a cover made from cowhide leather. However, the actual leather used in the cover of a ball need not be of the traditional type for a particular variety of game ball. For the purposes of this invention, it is more important that the leather used possess the necessary performance properties, including sufficient resistance to water.

The leather used in the present invention is a tanned leather which has substantial water resistance properties imparted by the tanning process and the particular tanning chemicals used in the process. The tanning process imparts water resistance throughout the leather, with all the fibers of the leather acquiring water resistant properties. The tanned-in nature of the water resistance properties makes the leather less likely to absorb water than those leathers which have merely a topical water resistance treatment. The tanned-in water resistance is of particular importance when the ball receives prolonged or multiple exposures to wet conditions.

The water resistance properties of different leathers can be compared in terms of the amount of water absorbed over a period of time by a given size sample of leather. For the purposes of this application, water resistance is expressed as a ratio of the combined weight of a leather sample and the water absorbed after a specific period of immersion in water compared to the original dry weight of the leather sample. It will be appreciated that a sample of leather which has a low ratio, that is, a ratio approaching 1:1, has better water resistance than a sample with a higher ratio.

To achieve the goals of the present invention, the leather used in the game ball should have a ratio of the combined weight of the leather sample and the water absorbed after immersion in water for 45 minutes compared to the original dry weight of the leather sample in the range of 1.01:1 to 1.5:1. Preferably, the ratio should be in the range of 1.02:1 to 1.3:1, and most preferably, 1.05:1 to 1.2:1. Similarly, a football made according to the invention should have a ratio of 1.2:1 or less after 45 minutes of immersion in water.

Leather meeting the requirements of the present invention may be commercially obtained from a leather supplier such as Pittard's, Inc., Leeds, England or Bali Leathers, Inc., Johnston, New York. Specific examples of leathers having waterproofing or water resistance properties which meet the requirements of this invention

are available from Pittard's, Inc. under the designations Pittard's WR2000TC and WR100 leather.

Leather tanned using the Pittard's process and chemicals results in a permanent tanned-in water resistance which permeates the leather and imparts water resistance properties to all the fibers of the leather. Leather which is treated in this way is highly resistant to water in the liquid form, but permits the passage of water vapor through the leather rather freely.

Page 9, line 1 to page 10, line 21.

Applicants provided specific examples of commercially available leathers for use as the leather cover. That is, it is noted that leathers available under the designations WR2000TC and WR100 from Pittard's, Inc. meet the requirements of, and can therefore be utilized in, the claimed subject matter of claim 3.

The Examiner asserts that Applicants have not disclosed the process which imparts the water resistant properties to the leather.

The Examiner is applying a different standard than that which § 112, first paragraph, requires. First, Applicants are not claiming a process for increasing the water resistance properties of a leather. Instead, claim 3 recites a game ball that comprises, in part, tanned leather, that exhibits particular water resistance properties. The specification provides specific examples of commercially available tanned leathers that can be utilized in the claimed game ball. It is repeatedly noted in the quoted passages of the specification that the tanning process of the leather is the process which imparts water resistance properties to the leather. It is also noted that the particular chemicals used in the tanning process impart the water resistance properties to the leather. The specification even notes that it is these "tanned-in" water resistance properties that render the noted leathers suitable for use in the present invention as compared to leathers which merely have a topical water resistance.

The Examiner further argues that the range of weight ratios is not supported by the present specification. Applicants respectfully submit that such support is in fact present.

Independent claim 3 recites that the ball is subjected to six, 45-minute cycles of a rain test. Claim 3 further recites that the ball contains a maximum amount of water, expressed as a ratio of the weight of the ball with absorbed water to the weight of the dry ball, being a maximum of 1.20:1. This is not a range as characterized by the Examiner, but instead a maximum amount of water.

Support is found in the originally filed application for this aspect. It is noted beginning on page 10, line 23 of the application that, "[i]f a game ball of the present invention having a leather cover and a lining is subjected to the 'rain test'...for a period of 45 minutes, the ball would absorb a limited amount of water which is expressed as the absorption ratio. This ratio is noted as having an upper limit of 1.2:1. See page 11, line 1. Furthermore, the feature of repeated water resistance is described on page 11, lines 8-13. There, this characteristic is described as the ball maintaining an absorption ratio of less than 1.2:1, after six cycles of a 45 minute rain test.

Again, it is earnestly submitted that the Examiner is applying a significantly higher standard than that which is required under § 112. The Board is requested to revisit Applicants' previous Response, and specifically pages 5 to 9 of that Response for an explanation of the correct standard for evaluating the written description requirement of § 112, and why the present application satisfies that requirement. In view of the foregoing, it is believed that the Board will agree that this ground of rejection must be reversed.

C. Rejection of Claim 3 for Alleged Lack of Enablement Must Be Reversed

The Examiner also rejected claim 3 by contending:

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 3, the application as originally filed does not provide support for a game ball without a bladder. The game balls used to conduct the rain test in Example 1 having a cover, a lining and a bladder, and in Comparative Example 1, the game ball having a Cover and a bladder. No information has been provided to lead one to believe that additional rain tests were conducted for game balls not having a bladder. It is unclear how the claimed ranges were obtained, since there are no tables to support such limitations? Therefore, it is not readily apparent from the claim language that a bladder is present for the claimed game ball.

Page 3 of the Office Action mailed April 2, 2004.

This ground of rejection is entirely unsupported and must as a matter of law be reversed. The Examiner did not submit any evidence or scientific reasoning to support the view that an artisan could not make the claimed game ball without a bladder. The Board is respectfully reminded that the MPEP states in this regard, "[t]he examiner should never make the determination [of enablement] based on personal opinion." MPEP § 2164.05 (emphasis in original, bracketed text added).

In rejecting claim 3 under § 112 for alleged lack of enablement, the Examiner attempts to ignore or bypass the long recognized standard test for determining whether claimed subject matter is sufficiently enabled by a specification.

The standard for determining whether the specification meets the enablement requirement was set forth in *Mineral Separation v Hyde*, 242 U.S. 261, 270 (1916), as "is the experimentation needed to practice the invention undue or unreasonable?" And, according to § 2164.01 of the MPEP, this standard is "still the one to be applied." See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with

information known in the art without undue experimentation.” See *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988).

Claim 3 recites a game ball comprising in part, a natural leather cover disposed over a lining. Claim 3 encompasses game balls with a bladder and those without a bladder.

On page 4 of the present specification, the types of game balls that may be suited for the present invention are noted:

[A] game ball which includes a lining having water resistant properties over which a leather cover is disposed having water resistant properties. Typically, balls featuring this construction include an air bladder. However, balls of other types of construction (including those made with central cores or centers) may also benefit from use of this invention.

Page 4, lines 12-18.

It is further noted that:

It is envisioned that any game ball can advantageously be constructed according to the present invention including, but not limited to, those game balls traditionally constructed with an outer cover and inner bladder, or optionally, those constructed with a lining disposed between the cover and bladder. Such game balls include, but are not limited to, American-style footballs, rugby balls, soccer balls, volleyballs, and basketballs. It is further envisioned that other leather covered balls may benefit from the present invention, including those balls which have a construction which traditionally features a cover and a core, such as baseballs and softballs.

Page 6, lines 1-10.

The Examiner is taking a position that an artisan in this field of art armed with the present disclosure coupled with information known in the art, would be unable to make the game ball of claim 3 if such game ball did not have a bladder. Moreover, even in the unlikely scenario that the artisan needed to conduct several trials in such a fabrication, the law provides great latitude by qualifying the standard with the requirement that if such experimentation is necessary, it must not be undue.

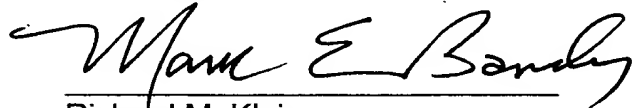
Additionally, the Board is asked to reconsider pages 9-11 of Applicants' Response filed December 29, 2003² in which the correct standard as pronounced by the Federal Circuit for evaluating enablement under § 112 is noted, and the reasons why the current application satisfies such are presented. In view of the foregoing, it is respectfully submitted that this ground of rejection must, as a matter of law, be reversed.

² This was in response to the Office Action mailed June 26, 2003.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the objection and rejections are in error and that claim 3 is in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claim 3.

Respectfully submitted,



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RMK:MEB/mat

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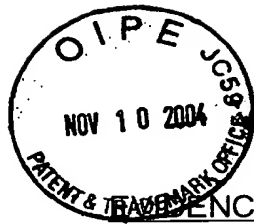


Application No. P-5761-SPALD
RUSS 200007

CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

3. (Appealed) A game ball having increased resistance to moisture absorption comprising a natural leather cover disposed over a lining, the leather of said cover having increased water resistance properties distributed throughout during a tanning process, wherein when said ball is subjected to six 45 minute cycles of a rain test and said ball is permitted to dry at approximately 70°F for 24 hours between cycles, said ball contains an amount of water at the conclusion of each said rain test cycle as expressed as a ratio of the weight of the ball with absorbed water to the weight of the dry ball, an average per cycle ratio at the conclusion of said six rain test cycles being a maximum of 1.20:1.



Application No. P-5761-SPALD
RUSS 200007

REFERENCE APPENDIX

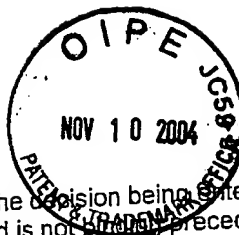
NONE



Application No. P-5761-SPALD
RUSS 200007

RELATED PROCEEDINGS APPENDIX

A copy of the decision and opinion by the Board of Patent Appeals and Interferences in Appeal No. 2002-0979 is attached herewith.



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN FEENEY and CHRIS WALDECK

Appeal No. 2002-0979
Application No. 09/248,595

ON BRIEF

MAILED

JAN 27 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 8-12, 17 and 18, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to game balls, such as footballs, having improved moisture resistance (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

JAN 30 2003

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Friese et al. (Friese)	4,755,187	Jul. 05, 1988
Walters	5,069,935	Dec. 03, 1991

The following rejection is before us for review.

Claims 1-6, 8-12, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Friese in view of Walters.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 23) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 22 and 24) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims 1-6, 8-12, 17 and 18 as being unpatentable over Friese in view of Walters, the examiner finds that Friese discloses a method of waterproofing leather including tanning using fatliquoring agents. As noted by Friese (column 3, lines 46-49), the leathers obtained by the disclosed process are soft with a pleasant "lardy"

feel and are "particularly suitable for the production of shoe upper leather, garment quality suede and heavy suede." The examiner concedes that Friese does not teach use of the resulting leather to make a football (or other game ball), but asserts that Friese also does not teach away from such use of the leather (answer, page 3).

According to the examiner, it would have been obvious, in view of the teachings of Walters of a game ball with a tanned leather cover having moisture resistance properties, to use the "fatliquored" leather of Friese on the football of Walters "in order to provide a waterproofed leather football with improved water proofing properties" (answer, page 4). For the reasons set forth on pages 15-17 of appellants' brief, we do not agree with the examiner. As pointed out by appellants, Walters specifically teaches that the key to the Horween leather used for making American footballs is its "tanned-in tack" (column 1, lines 24-34); an "oily, slippery feeling is not acceptable since it affects the playability of the football" (column 4, lines 36-37). Accordingly, one of ordinary skill in the art at the time of appellants' invention would have appreciated from the teachings of Walters that the "lardy" (oily, slippery) characteristic of the leather produced using Friese's tanning process would have rendered such leather unsuitable for use in making an American football.

Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353,

1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Accordingly, in light of the above discussion, we conclude that one of ordinary skill in the art at the time of appellants' invention would not have been motivated to make the combination proposed by the examiner. It thus follows that we cannot sustain the examiner's rejection.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 11 is rejected under 35 U.S.C. § 102(b) as being anticipated by Walters.

Claim 11 reads as follows:

A game ball having improved resistance to water absorption comprising a cover of natural leather having a treatment to impart improved water resistant properties throughout the entirety of the leather, said treatment comprising tanning of said leather with chemicals prior to application of said cover to said game ball.

Unlike the remaining claims pending in this application, claim 11 does not recite any specific degree of water resistance. All claim 11 requires is a game ball comprising a cover of a leather which has been treated so as to impart improved water resistance, the treatment comprising tanning with chemicals prior to application of the cover to the game ball. Walters' football is made with a steer hide leather cover which has been tanned using a "chrome type" tannage process followed with a vegetable retannage.

This tanning process will inherently impart some improvement in water resistance. In any event, the additional treatment of the leather panels with polyfluoroalkyl material¹ as disclosed by Walters prior to constructing the football certainly imparts improved water resistance properties to the football cover, as taught by Walters. The Walters football thus meets all of the limitations of claim 11 so as to anticipate² claim 11.

REMAND TO THE EXAMINER

We remand this application to the examiner in accordance with 37 CFR § 1.196(a) for consideration of whether the particular water resistance standards recited in claims 1-6, 8-10, 12, 17 and 18 are supported by the application as originally filed so as to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112. While Tables 1(A) and 1(B) may disclose examples of appellants' invention which fall within the ranges of wet to dry ratios recited in these claims, it is not immediately apparent to us where support is found in the application as originally filed for the full scope of the presently claimed ranges.

¹ Such additional treatment to help impart the improved water resistant properties is not precluded, in light of the use of the term "comprising" in claim 1 following "treatment," since the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements. See In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

² Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Taking claim 1 as an example, Table 1(B) of appellants' specification (page 15) discloses one tested example of appellants' invention wherein the ratio of the ball weight with absorbed water to the dry ball weight after being subjected to three 90 minute cycles of a rain test is 1.13:1, which is clearly less than the recited maximum of 1.25:1. Appellants' original disclosure, however, does not appear to convey possession of the full range (up to a maximum of 1.25:1) of weight ratios now recited in claim 1.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Applying this standard, upon remand, the examiner should review the specification and claims to determine whether appellants' original disclosure provides written descriptive support for the subject matter now recited in claims 1-6, 8-10, 12, 17 and 18. If the examiner is unable to identify where in appellants' original disclosure support can be found for each of the ratio ranges recited in these claims, the examiner should consider rejecting the claims under the first paragraph of 35 U.S.C. § 112.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6, 8-12, 17 and 18 under 35 U.S.C. § 103 is reversed. A new rejection of claim 11 is entered pursuant to 37 CFR § 1.196(b) and the application is remanded to the examiner for consideration of the written description issue discussed above.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) and a remand pursuant to 37 CFR §§ 1.196(a) and (e).

37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."


37 CFR § 1.196(e) provides that:

Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

REVERSED; 37 CFR § 1.196(b) and REMANDED


JENNIFER D. BAHR
Administrative Patent Judge

jdb/vsh

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